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March 31, 2006

### **BY ELECTRONIC FILING**

The Honorable Gregory M. Sleet  
United States District Court  
District of Delaware  
844 North King Street  
Lockbox 19  
Wilmington, Delaware 19801

Re: *Thermo Finnegan LLC v. Applera Corp.*,  
Civil Action No. 04-1505-GMS

Dear Judge Sleet:

Pursuant to District of Delaware Local Rule 7.1.2(c), Applera respectfully calls the Court's attention to the Federal Circuit's decision, issued today, in *On Demand Machine Corp. v. Ingram Industries, Inc.*, C.A. Nos. 05-1074, -1075, -1100 (Fed. Cir. Mar. 31, 2006) (slip opinion attached as Exhibit A), which is pertinent to all of the claim construction issues before the Court. In *On Demand*, the Federal Circuit held that the district court's construction of the term "customer" based on a standard dictionary definition was error, and held that in the context of the patent in suit the term was limited to a retail customer. Slip op. at 12. The Federal Circuit rejected the patentee's argument that it did not disavow the standard dictionary meaning of "customer," stating that "when the scope of the invention is clearly stated in the specification, and is described as the advantage and distinction of the invention, it is not necessary to disavow explicitly a different claim scope." *Id.* The Federal Circuit went on to confirm the primary role of the specification in claim construction:

In *Phillips*, 415 F.3d at 1321, the *en banc* court explained that the role of the specification is to describe and enable the invention. *In turn, the claims cannot be of broader scope than the invention that is set forth in the specification.*

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*Id.* at 13 (emphasis added). The Federal Circuit cautioned that construction of individual claim terms, divorced from the context provided by the specification's description of the invention, could lead to an improper construction that "departs significantly from the patented invention." *Id.* at 19.

We are available at the Court's convenience should the Court have any questions on this case or any other aspect of the claim construction issues before the Court.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Josy W. Ingersoll", with a stylized flourish at the end.

Josy W. Ingersoll (No. 1088)

JWI/cg

cc: Clerk, U.S. District Court (by e-filing and hand delivery)

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